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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,599	12/02/2003	Stephen Bailey	117873	2608

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EXAMINER

EVANS, GEOFFREY S

ART UNIT	PAPER NUMBER
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1725

DATE MAILED: 02/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/724,599

Applicant(s)

BAILEY ET AL.

Examiner

Geoffrey S Evans

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6 and 9-12 is/are rejected.
- 7) ☒ Claim(s) 3,7 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 20050209.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1,4,6,9,10,11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanishiki et al. in U.S. Patent No. 6,180,908 B1. Tanishiki et al. discloses apparatus and a method of electric discharge machining a passage through a work piece (element 5) using a hollow electrode (element 10) wherein a discrete backing member (element 14) is positioned abutting a face of the work piece through which the electrode exits so that at breakthrough of said electrode through said workpiece the path of flushing agent is not disrupted (see column 5, line 63 to column 6, line 21). In column 6 lines 10-11 the language "Since the jig 14 is attached to the bottom of the workpiece 5..." shows that the discrete backing member abuts the workpiece. The final product made by Tanishiki is considered identical to the final product of claims 4, 9 and 10. Regarding claims 11 and 12, Tanishiki et al. discloses that the concave portions or recesses (element 14a) in the backing member is positioned opposite the breakthrough region on the face of the workpiece (see column 6, lines 28-33).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanishiki et al. in U.S. Patent No. 6,180,908 B1 in view of Tanaka in U.S. Patent No. 5,004,530. Tanaka teaches a liquid tight contact between the workpiece and the backing member in column 2, lines 39-42. It would have been obvious to adapt Tanishiki et al. in view of Tanaka to provide this to maintain the fluid pressure during machining.

6. Claims 4, 5, 9, 10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wilkinson et al. in U.S. Patent No. 4,159,407. Wilkinson discloses a substantially identical workpiece of an aerospace component (e.g. see column 1, lines 46-47) that has a hole formed with machining fluid is within the workpiece, thereby preventing any machining fluid pressure drop caused by the break through of the electrode through the workpiece. When the prior art discloses a product, which reasonably appears to be either identical with or slightly different than a product claimed in a product-by-process claim, the burden is on applicant to present

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evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. See In re Fessman, 489 F2d 742,180 USPQ 323 (CCPA 1974) and In re Marosi, 710 F2d 799, 218 USPQ 195 (Fed. Cir. 1983).

6b. Claims 4,5,9,10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ben-Amoz in U.S. Patent No. 4,923,371. Ben-Amoz discloses a substantially identical workpiece of a turbine blade with a through-hole that can be made by a laser beam (e.g. see column 6, lines 4-8).

When the prior art discloses a product, which reasonably appears to be either identical with or slightly different than a product claimed in a product-by-process claim, the burden is on applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. See In re Fessman, 489 F2d 742,180 USPQ 323 (CCPA 1974) and In re Marosi, 710 F2d 799, 218 USPQ 195 (Fed. Cir. 1983).

7. Claims 3,7, and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


8. Applicant's arguments with respect to claims of record have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey S Evans whose telephone number is (571)-272-1174. The examiner can normally be reached on Mon-Fri 6:30AM to 4:00 PM, alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (571)-272-1171. The fax phone number for the organization where this application or proceeding is assigned is (703)-872-9306.

GSE


Geoffrey S. Evans
Primary Examiner
Group 1700